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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/867,746	05/31/2001	Bijan Tadayon	111325-63	5716
22204	7590	07/14/2005	EXAMINER	
NIXON PEABODY, LLP 401 9TH STREET, NW SUITE 900 WASHINGTON, DC 20004-2128			SHERR, CRISTINA O	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 07/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/867,746	Applicant(s) TADAYON ET AL	
	Examiner Cristina Owen Sherr	Art Unit 3621	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 April 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This communication is in response to applicant's amendment filed April 20, 2005. Claims 1 and 9 have been amended. Claims 1-14 are pending in this case.

#### ***Information Disclosure Statement***

2. Applicant refers to two (2) information disclosure statements filed on August 30, 2002 and September 27, 2002. The documents are not in the file, and have not, therefore, been considered. Applicant is requested to resubmit said documents, with the USPTO's apologies for any inconvenience.

#### ***Response to Arguments***

3. Applicant's arguments filed April 20, 2005 have been fully considered but they are not persuasive.
4. Applicant argues that claims 1 and 9, as amended, are distinguishable from Stefik et al (US 5,638,443) in that Stefik does not specifically disclose allocating user rights between the first user and the second user such that the first user and the second user each have an allocated percentage of the usage rights that is greater than zero (0) and less than one hundred (100) percent. In Stefik, at col 6 ln 16-48:

FIG. 1 is a high level flowchart omitting various details but which demonstrates the basic operation of the present invention. Referring to FIG. 1, a creator creates a digital work, step 101. The creator will then determine appropriate usage rights and fees, attach them to the digital work, and store them in Repository 1, step 102. The determination of appropriate usage rights and fees will depend on various economic factors. The digital work remains securely in Repository 1 until a request for access is received. The request for access begins with a session initiation by another repository. Here a Repository 2 initiates a session with Repository 1, step 103. As will be described in greater detail below, this session initiation

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includes steps which helps to insure that the respective repositories are trustworthy. Assuming that a session can be established, Repository 2 may then request access to the Digital Work for a stated purpose, step 104. The purpose may be, for example, to print the digital work or to obtain a copy of the digital work. The purpose will correspond to a specific usage right. In any event, Repository 1 checks the usage rights associated with the digital work to determine if the access to the digital work may be granted, step 105. The check of the usage rights essentially involves a determination of whether a right associated with the access request has been attached to the digital work and if all conditions associated with the right are satisfied. If the access is denied, repository 1 terminates the session with an error message, step 106. If access is granted, repository 1 transmits the digital work to repository 2, step 107. Once the digital work has been transmitted to repository 2, repository 1 and 2 each generate billing information for the access which is transmitted to a credit server, step 108. Such double billing reporting is done to insure against attempts to circumvent the billing process.

Although Stefik does not specifically allocate usage rights in such a manner, it would be obvious to one ordinary skill in the art to allocate usage rights in differing amounts and to different numbers of users. Merely dividing things differently does not constitute patentable material.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stefik et al (US 5,638,443).

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## 7. Regarding claim 1 –

Stefik teaches a method of transferring and managing rights from user to another comprising (e.g. column 18 lines 9-22 and Fig. 14): associating usage rights, transfer permission information, and a current user identification flag, with digital content (e.g. column 6 lines 16-48 and Fig. 1); electronically distributing a digital work including the content to a first user in accordance with the usage rights and setting the current user identification flag to correspond to the first user (e.g. column 18 lines 9-26 and column 22 lines 19-28 and Fig. 14); and transferring the digital work to a second user and setting the current user identification flag to correspond to the second user, wherein usage rights are allocated based on a percentage partially allocated between the first user and the second user (e.g. column 18 lines 9-26 and column 22 lines 19-28 and Fig. 14).

8. Stefik does not specifically disclose allocating user rights between the first user and the second user such that the first user and the second user each have an allocated percentage of the usage rights that is greater than zero (0) and less than one hundred (100) percent. Although Stefik does not specifically allocate usage rights in such a manner, it would be obvious to one ordinary skill in the art to allocate usage rights in differing amounts and to different numbers of users. Official notice is taken that merely adding new repetitive steps or dividing things differently does not constitute patentable material. Further, it would be obvious to one of ordinary skill in the art to extend Stefik in the manner described in order to obtain greater flexibility in the distribution of usage rights, as in paragraph 4, above.

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10. Regarding claims 2-8 –

Stefik discloses a method as recited in claim 1, wherein said transferring step comprises changing the usage rights in accordance with the transfer to the second user; wherein said changing step comprises changing the usage rights to permit use of the content by the second user and to prohibit use of the content by the first user; further comprising receiving notification that the user desires to distribute the digital work to a second user; wherein said transferring step comprises transferring usage rights without change for remaining usage period of time to the second user; wherein said transferring step further comprises downloading the content from the first user to the second user; wherein said transferring step further comprises downloading the content from a distributor to the second user; and further comprising checking for transfer permission prior to said transferring step (e.g. col 6 lines 16-48 and column 18 lines 9-22).

11. Regarding claim 9-

Stefik discloses a system for transferring digital works from one user to another user comprising: digital content; a usage rights module containing usage rights information associated with the content for a first user; a transfer permission module containing transfer permission information for the content; a current user identification module containing identity information indicating the identity of the first user; and means for manipulating said current user identification module to change the current user identification flag of the identity information from a current user to a second user upon transferring the content from the first user to the second user, wherein usage rights are

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allocated based on a percentage partially allocated between the first user and the second user (e.g. col 6 lines 16-48 and column 18 lines 9-22).

12. Stefik does not specifically disclose allocating user rights between the first user and the second user such that the first user and the second user each have an allocated percentage of the usage rights that is greater than zero (0) and less than one hundred (100) percent. Although Stefik does not specifically allocate usage rights in such a manner, it would be obvious to one ordinary skill in the art to allocate usage rights in differing amounts and to different numbers of users. Official notice is taken that merely adding new repetitive steps or dividing things differently does not constitute patentable material, as in paragraph 4, above. Further, it would be obvious to one of ordinary skill in the art to extend Stefik in the manner described in order to obtain greater flexibility in the distribution of usage rights.

13. Regarding claims 10-14 –

Stefik discloses a system as recited in claim 9, further comprising means for changing the usage rights in accordance with a change in identity information; wherein said usage rights module and said digital content are encrypted; wherein said usage rights module and said digital content are attached to one another as an encapsulated element; wherein said transfer permission module and said current user identification module are located remotely from said encapsulated element; wherein said means for manipulating said current user identification module is responsive to a notification that the first user desires to distribute the digital work to the second user (e.g. col 11 ln 16-27, col 11 ln 32-42).

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14. Examiner's note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may be applied as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention as well as the context of the passage as taught by the prior art or disclosed by the examiner.

#### ***Conclusion***

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

16. Ginter et al (US 6, 427,140) discloses systems and methods for secure transaction management and electronic rights protection.

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

18. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any



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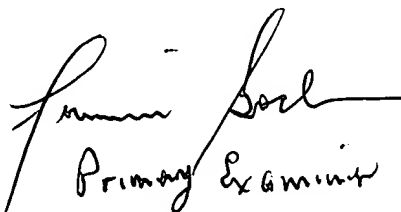
extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cristina Owen Sherr whose telephone number is 571-272-6711. The examiner can normally be reached on 8:30-5:00 Monday through Friday.

20. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

21. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Primary Examiner  
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